

REMARKS

Status of the claims:

With the above amendments, claim 3 has been canceled and claim 1 has been amended. Thus, claims 1, 2, and 4-13 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Claim 1 has been amended by incorporation of the subject matter of claim 3. Moreover, the amendment to claim 1 has further support at page 8, lines 19-21. Entry of the amendments and reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §103

Claims 1-13 are rejected under 35 USC §103(a) as being unpatentable over the combination of EP '930 (EP 1 004 930) and Matsumoto '668 (US Patent No. 5,958,668).

Claims 1-13 are rejected under 35 USC §103(a) as being unpatentable over the combination of EP '812 (EP 0 962 812) and Matsumoto '668.

Applicants traverse.

Present Invention

The present invention, as recited in claim 1, relates to a heat-developable image recording material comprising:

a support;
a photosensitive silver halide;
a reducing agent for a silver ion;
a binder; and
a non-photosensitive organic silver salt grain,
wherein the non-photosensitive organic silver salt grain
has:

- 1) substantially no silver stearate;
- 2) a length/width ratio of 1 to 9;
- 3) an aspect ratio of 1.1 to 30; and
- 4) an equivalent-sphere diameter of 0.05 to 1 μm
- 5) a content of silver behenate that is 90 to 100 mol%
per mol of the non-photosensitive organic silver salt.

Disclosure of EP '930

EP '930 discloses a thermally developable photosensitive material having a photosensitive layer comprising a photosensitive silver halide, an organic silver salt, a reducing agent, and a binder. The thermally developable photosensitive material containing the organic silver salt has tabular organic silver salt grains having an aspect ratio of at least 3, and the average of needle ratio of the tabular organic silver salt grains measured from the principal plane direction is not less than 1.1 and less

than 10. The thermally developable photosensitive material is said to exhibit high sensitivity and low fog.

Disclosure of Matsumoto '668

Matsumoto '668 discloses a recording medium comprising a support having thereon a recording layer comprising an organic silver salt, a developing agent for the organic silver salt, a water-soluble binder and an antifoggant in an amount of from 10 mol % to 40 mol % based on the organic silver salt. The recording material is said to have a long shelf life and is said to provide a high-density image.

Disclosure of EP '812

EP '812 discloses fatty acid silver salt particles of an aqueous dispersion, which are formed by simultaneously adding into a reaction vessel (a) a silver ion-containing aqueous solution or a silver ion-containing water-organic solvent mixed solution and (b) an aqueous solution of an alkali metal salt of a fatty acid, a solution in a water-organic solvent mixed solvent, or a solution in an organic solvent, in an amount of at least 10% of the total amount of silver to be added, and the fatty acid silver salt particles formed satisfies all the following characteristics: (1) The average equivalent-sphere diameter of the fatty acid silver salt particles is from 0.1 μm to 0.8 μm ;

- (2) The average ratio of long sides/short sides in the main planes of the fatty acid silver salt particles is from 1 to 4;
- (3) The average aspect ratio of the particle is from 2 to 30; and
- (4) The average thickness of the particles is from 0.01 μm to 0.20 μm .

Removal of the Rejections over EP '930 and Matsumoto '668 as well as EP '812 and Matsumoto '668

The Examiner considers 1 mole % or less of silver stearate to encompass cases where there is no silver stearate. In particular, the Examiner points to page 25, lines 15-20 in EP '812 as an Example that has no silver stearate. The Examiner further asserts that the 37 CFR §1.132 declaration filed with the response of October 31, 2003 is not commensurate in scope with the claimed invention as no examples are shown that contain other organic fatty acids other than behenic acid. Applicants disagree for the following reasons.

Applicants note that at paragraph [0035] in EP '812 are listed a whole series of fatty acids including behenic acid and stearic acid. Thus, EP '812 appears to teach the equivalence of all of these fatty acids. The Examiner has pointed to an Example in EP '812 that contains no silver stearate (see page 25, lines 15-20 in EP '812). However, in the response filed April 11, 2003, Applicants presented attachments (and re-present those attachments

here) that show that the contents of this composition actually contained 2% stearic acid, 5.7% arachidic acid, and 88% behenic acid. Applicants emphasize that this is the commercially available Edenor C22-85R as disclosed as the composition that is used by EP '812. This "behenic acid", in reality, has the above-indicated concentrations of stearic acid, arachidic acid, and behenic acid. In other words, the example that is cited by the Examiner in EP '812 does, in effect, have silver stearate present in it in an amount that falls outside of the instantly claimed amount (*i.e.*, substantially no silver stearate (see claim 1) and a content of 1 mol% or less per mol of the non-photosensitive organic silver salt (see claim 13)).

Applicants, in the 37 CFR §1.132 declaration that was filed on October 31, 2003, tested an Example that contained 2.0% stearic acid, which is the same composition as that present at page 15, lines 15-20 in EP '812. In this declaration, it was shown that when the concentration of stearic acid is 2.0%, this results in an inferior change in percentage of image preservability relative to the examples that fall within the scope of the instant invention (*i.e.*, P, Q, S, and U) which have substantially no silver stearate (claim 1) or a content of 1 mol % or less (claim 13).

Moreover, the instant claim 1 has been amended to recite "a content of silver behenate that is 90 to 100 mol% per mol of the

non-photosensitive organic silver salt". Thus, the example cited by the Examiner at page 25, lines 15-20 in EP '812 has a behenic acid amount that falls outside of the instant invention. For this reason, Applicants submit that EP '812 cannot render *prima facie* obvious the instant invention.

Even if a proper *prima facie* case of obviousness were presented, which Applicants do not concede, the instant invention demonstrates unexpectedly superior results over the Example in EP '812 pointed out by the Examiner. The instant invention is unexpectedly superior in image preservability. For these reasons, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

EP '930 discloses 24% wt. or 3% wt. stearic acid in its examples. Thus, Applicants submit that not only does EP '930 not disclose or suggest the heat-developable image recording material that has substantially no silver stearate (claim 1) or content of 1 mol % or less (claim 13), but EP '930 appear to teach away from this amount, and thus, teach away from the instant invention.

As was noted above, Applicants in the 37 CFR §1.132 declaration that was filed on October 31, 2003, showed that when 2.0% stearic acid is used, this results in an inferior product regarding the percentage of image preservability. Thus, the instant invention demonstrates unexpectedly superior results relative to an example that is closer to the instant invention

than the invention of EP '930. Applicants submit that it is well recognized that it is acceptable to test an example that is closer to the claimed invention than the cited reference's closest example to show unexpected results. Please see 716.02(e) of the MPEP, which recites:

Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner. In re Holladay, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); Ex parte Humber, 217 USPQ 265 (Bd. App. 1961)

Applicants submit that it should be apparent to one of ordinary skill in the art that a composition that contains 2.0% of silver stearate is closer to the claimed "substantially no silver stearate" of claim 1 or "a silver stearate content of 1 mol% or less per mol of the non-photosensitive organic silver salt" of claim 13 than the 3% silver stearate that is the closest disclosed example in EP '930. Accordingly, the rejection over EP '930 is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

EP '930 also has a behenic acid amount that falls outside of the instantly claimed amount. Please note that in the attachment filed April 11, 2003, the amounts of behenic acid in the two closest examples are 42% and 85% for examples A and B, respectively. Please note that both of these examples fall outside of the claimed range of 90 to 100 mol% of silver behenate.

For this reason also the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Matsumoto '668 fails to make up for the deficiencies present in either of EP '812 or EP '930. Matsumoto '668 fails to disclose or suggest silver stearate or silver behenate that falls within the scope of the instant claims. Accordingly, Applicants believe that all of the rejections have been obviated. Withdrawal of the rejections are warranted and respectfully requested.

With the above remarks and amendments, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a response in connection with the present application. The required fee of \$950.00 is being filed concurrently with the Notice of Appeal.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: Resubmission of attachment from response filed on
April 11, 2003